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324	7590	04/25/2008	EXAMINER	
JoAnn Villamizar			ABU ALI, SHUANGYI	
Ciba Corporation/Patent Department			ART UNIT	
540 White Plains Road			PAPER NUMBER	
P.O. Box 2005			1793	
Tarrytown, NY 10591			MAIL DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,803

Applicant(s)

MULLER ET AL.

Examiner

SHUANGYI ABU ALI

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

(1)

Status of Claims

Claims 1, 4 and 5 remain for examination and claims 16 and 17 are new

(2)

Claim Rejections - 35 USC § 103

Claims 1, 4-5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. Patent No. 5,840,449 to Zambounis et al., in view of U.S. Patent No. 6, 280,511 to Schaedeli et al., further in view of U. S. Patent No. 5, 127,952 to Persello et al. as generally set forth in the previous office action mailed on 10/25/2007 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. Patent No. 5,840,449 to Zambounis et al. and U.S. Patent 6,280511 to Schaedeli et al., further in view of U. S. Patent No. 5127952 to Persello et al.

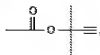
Regarding claim 16, Zambounis et al. disclose a composition comprising a substrate and a latent pigment. The substrate can be metal, metal oxide and polymeric material in any kind of form and composition. The latent pigment can be



A is the radical of a chromophore of the quinaclidone, anthraquinone, perylene, indigo, azo, quinophthalone, isocindolinone, isocindoline, dioxazine, phthalocyanine or diketopyrrolopyrrole series which contains nitrogen atoms attached to D_1 and to $x D_2$, each nitrogen atom present in A being able independently of the others to be attached to 0, 1 or 2 groups D_3 or D_4 .

D_1 and D_2 are hydrogen, x is an integer from 0 to 4, and

and especially those in which x is 1 and D_3 and D_4 are identical and are groups of the formula



Although they disclose that latent pigment can be deposited on the substrate by any desired technique, they are silent about the technique set forth in claim 1.

However, Schaedeli et al., also drawn to a composition comprising a polymeric material and a latent pigment, disclose a process to prepare a pigmented composition (col. Lines 7-13). A substrate is added into a solution comprising pigment precursors followed by precipitation of the pigment precursors thereon (col.28, lines 10-14). A suitable Brønsted acid is then contacted with the substrate to convert the pigment precursors into pigment (col. 29, line 55-57). The latent pigment may have the following structure:



(I)

in which

A represents a residue of a colorant of the anthraquinone, azo, quinacridone, quinophthalone, diketopyrrolopyrrole, dioxazine, indanthrone, indigo, isoindoline, isoindolinone, perylene, or phthalocyanine series, which is linked to x groups B via one or more of its hetero atoms, wherein such hetero atoms are selected from the group consisting of N, O or S, and are part of the molecular structure of A, and

B is either a hydrogen atom or a solubilizing group which can be split off by heat and/or a Brønsted acid, with the proviso that at least one of the groups B in formula (I) is not a hydrogen atom, and

x is an integer from 1 to 8.



R_{1-2} represents a hydrogen atom; C_1-C_6 alkyl or a group

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use Schaedeli et al. method to make Zambounis et al. composition, motivated by the fact that Schaedeli et al. disclose that their method has the advantage that the latent pigment precipitated very fast in the substrate and the pigment particles have a small size and uniform distribution (col. 28, lines 34-37).

But combined teaching of Schaedeli et al. and Zambounis et al. are silent about the carrier material is a pigment as applicant set forth in claim 16, However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to color a pigment by the method disclosed by combined teaching of Schaedeli et. al and Zambounis et al., motivated by the fact that Persello et al., drawn to a dye comprising pigment, disclose that the pigment displays a completed desired range of color and compatible with a great number of material and exhibits improved mechanical and chemical resistance (col. 1, lines 55-58).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of U. S. Patent No. 5,840,449 to Zambounis et al., and U.S. Patent 6,280,511 to Schaedeli et al., further in view of U. S. Patent No. 3,877,957 to Bradley et al.

Regarding claim 17, combined teaching of Schaedeli et al. and Zambounis et al. disclose a method of making latent pigment composition set forth above. But they are silent about organic pigment is used as carrier. However, it would have been obvious to one of ordinary skill in the art at the time of invention by

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applicant to color an organic pigment by the method disclosed by combined teaching of Schaedeli et. al and Zambounis et al., motivated by the fact that Bradley et al., also drawn to a dye comprising pigment, disclose that organic pigment has improved properties when it is coated with another organic pigment (col. 1, lines 24-29).(col. 1, lines 55-58).

(4)

Response to Arguments

Applicant's arguments filed 01/28/2008 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1 and 4-5 as indicated in the previous Office Action stand.

Applicants argue that Zambounis are not coating particles. The Examiner respectfully submits that Zambounis discloses that any form of substrate can be used in their composition. Zambounis further discloses that any know coating method can be used to coating the substrate.

Applicants argue that Zambounis are silent about subjecting their composition to the process of pigmentation of plastic. The Examiner respectfully submits that there is no such limitation on the instant application claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the intended use of colored carrier) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, a recitation of the

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intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. I

Applicants argue that the latent pigment is precipitated inside of the polymeric bead. The Examiner respectfully submits that when the bead in the dispersion, the latent pigment will be deposited on the surface of the bead as well. The applicants did not provide any evidence that there is no coating on the bead surface. Applicant's argument can not take the place of evidence. Furthermore, there is no limitation on the instant application that the latent pigment is only on the surface of the carrier. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the latent pigment is only on the surface of the carrier) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Persello disclose a method having different use. The Examiner respectfully submits that Persello et al. is used to show inorganic pigment can be used as a carrier in a pigment composition , which comprising a carrier(a substrate) and dye.

(5)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

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